TFW 2612

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Kenneth A. Parulski, et al

DIGITAL CAMERA PROVIDING IMAGE PROCESSING FOR AN ATTACHABLE PRINTER

Serial No. 09/800,158

Filed 06 March 2001

Group Art Unit: 2612

Examiner: Brian J. Jelinek

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Gina Marie Schmitt

Gina Marie Schmitt

December 22, 2005

Date

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

Request for Reconsideration

The Office Action dated November 2, 2005 has been received and reviewed by the applicant. Each claim stands rejected as either anticipated by Ogawa, et al. or as being unpatentable over Ogawa et al. in view of one or more secondary references.

Applicant previously presented a declaration of prior invention along with evidence of showing completion of the invention prior to the effective date (January 30, 1997) of Ogawa et al., coupled with diligence from a time just prior to the date of the reference continuously up to the filing date (April 4, 1997) of the parent applicant.

In the Office Action of November 2, 2005, the Examiner suggests that the evidence does not prove conception prior to January 30, 1997 because the evidence does not disclose (1) an image processor adapted to perform first processing and compression to create a first processed image file, (2) selecting an image from memory, and (3) performing second processing on the selected digital image file before applying the image to the interface. This position is respectfully traversed.

Document 2 of the Inventors' declaration notes with respect to a digital camera, *"[m]emory resources must already exist in the camera in order for the camera to do a frame grab from its electronic image sensor. Computing resources must also already exist in the camera in order to perform color filter array interpolation, compression, and file management."* It is clear from this passage that the evidence discloses an image processor adapted to perform first processing and compression to create a first processed image file. Note that at this point, the inventor is describing the background of the invention, and does not suggest that there is any novelty in these features per se.

The same document notes that, *"Rather than duplicate computing and/or memory resources that are in the camera by also putting them into a printer, a system consisting of an electronic camera and a printer may be built; wherein the memory and computing resources exist only in the camera."* While conventional printers used with electronic cameras require either an external computer or must contain computing resources, the inventive contribution eliminates duplication of computing and/or memory resources that are already in the camera. Thus, the camera's computing and memory resources could perform the computing needs conventionally provided outside of the camera. In document 3 of the declaration submitted with the inventors' declaration, Jeffrey Small states *"My idea is to perform 'printer process-specific' preconpensatin in the camera rather than in the printer. My idea's primary advantage is that the printer may be simplified because resources that are adequate to do the printer process-specific processing already exist in many cameras. By doing the processing in the camera, such resources need not be provided in the printer."* The proof of conception need not set forth the invention in the specific terms used when the claims are drafted; but merely must show that the inventor mentally possessed the claimed features. From the quoted passages, it is clear that the inventor at least mentally possessed features of selecting an image from memory and performing second processing on the selected digital image file before applying the image to a printer interface.

Document 2 of the Inventors' declaration is dated August 13, 1996, and was twice witnessed on August 13 and August 14 of that year. As such, it is respectfully submitted that inventor Jeffrey Small had conceived of the invention set forth in Claims 1 and 14 of the present application prior to January 30, 1997.

The Examiner further suggests in the Office Action of November 2, 2005, that the evidence does not establish diligence between just before January 30, 1997 and the April 4, 1997 filing date of the parent application. The Examiner cites In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) for its holding that a 2-day period lacking activity is fatal as his basis for this position. Mulder is distinguishable from the present application. In Milder, the court of Appeals relied on the fact that the applicant admitted "that there is no evidence whatever of record showing diligence." The Court "affirmed because of a total lack of evidence of diligence to *couple* conception to the filing date."

In the present application, there is not a total lack of evidence of diligence. In fact, the evidence shows that Attorney Milton Sales, together with inventor Jeffery Small, was diligently working towards a constructive reduction from a date prior to January 30, 1997 until April 4, 1997, the filing date of a patent application that was to become the basis for the constructive reduction to practice. Because the facts do not show a total lack of evidence of diligence as in Mulder et al., that case is distinguished, and the issue becomes not whether there was evidence of diligence, but rather, whether the evidence is sufficient.

The attached declaration of attorney Milton Sales makes it clear that he, with the assistance of inventor Jeffrey Small were diligently working toward the filing of the parent application. The evidence shows that before January 30, 1997, attorney Sales had instructed inventor Small to prepare a set of sketches to be used in the preparation of the application; that the sketches were delivered to attorney Sales on or about March 17, 1997, and that the patent application was drafted, signed and filed by April 4, 1997.

The evidence further shows that attorney Sales had an extremely large workload, and that the period for preparation of the application was substantially less that the assignee's goal for such work. The evidence also shows that inventor Small and attorney Sales were aware that Lab Head William (Bill) Fowlkes had put some urgency on the matter, and that they reacted accordingly.

In this regard, a case more relevant than In re Mulder would be Emery v. Ronden, 188 USPQ 264, 269 (Bd. Pat. Inter. 1974, also cited in MPEP 2138.06. Emery v. Ronden holds that "reasonable diligence does not require a patent attorney engaged in a normal practice to concentrate on any one application

to the exclusion of others....It is not necessary that an inventor or his attorney should drop all other work and concentrate on the particular invention involved."

For the reasons set forth above, it is believed that attorney Sales and those who assisted him, including inventor Small, were diligent in the preparation the application from a date prior to January 30, 1997 until April 4, 1997. Accordingly, Ogawa et al. is overcome as a reference and the present application is in condition for allowance. Reconsideration and favorable action are respectfully requested.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayments in connection with this communication to Eastman Kodak Company Deposit Account No. 05-0225. ***A duplicate copy of this communication is enclosed.***

Respectfully submitted,

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.